

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

BELL, INC.

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VS.

BELL PACKAGING CORP.

Registration No. 2,089,082

Respondent.

The Notice of Deposition of Mark Graham, President of Bell, Inc., was scheduled to be taken on December 2, 2002, in the United States, in Sioux Falls, South Dakota, and was served by first class U.S. mail on November 22, 2002. Thus, service was effective five days later on November 27, 2002, the day before Thanksgiving. A copy of the Notice is attached hereto as

Exhibit A. Respondent submits that there was not due notice of the scheduled deposition because it was scheduled merely five days following effective service of the Notice, which included the Thanksgiving holiday. Furthermore, Petitioner failed to follow the appropriate procedures for a deposition on written questions because the deposition was scheduled prior to the expiration of Respondent's opportunity to oppose the deposition, and prior to the expiration of the time periods set forth in 37 C.F.R. 2.124(d) for serving cross questions, redirect questions, recross questions, objections, and substitute questions. Respondent therefore respectfully requests this Board to quash Petitioner's Notice of Testimonial Deposition.

In the alternative, if the deposition went forward as scheduled, Respondent files this motion to Strike Trial Testimony Deposition of Mark Graham apparently taken on December 2, 2002, in Sioux Falls, South Dakota pursuant to 37 C.F.R. 2.123(c) and T.B.M.P. §2.124(d). Respondent received only one week actual notice, and five days effective notice based on service by first class mail, prior to the date scheduled for the deposition on written questions.<sup>1</sup> The Notice of the deposition was not served in a reasonable time prior to the scheduled date, and the schedule did not comply with the procedures set forth in 37 CFR 2.124(d). Respondent did not have any opportunity to cross examine the witness.

If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service after notice (20 days if service of

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<sup>1</sup> Respondent informs this Board that the attorney handling this Cancellation Proceeding, Pamela Ratliff, was hospitalized on November 24th and 25th, and due to the Thanksgiving holiday on November 28, 2002, Respondent was unaware of the scheduled deposition on written questions until on or after the date the deposition was scheduled. If needed, Respondent requests permission to submit a declaration under oath attesting to those facts, however Respondent believes it has a firm basis for this Board to quash the Notice or the deposition without those extenuating circumstances.

the notice was by first-class mail) file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination. TBMP § 714.01(a)(1)

Respondent hereby opposes Petitioner's Notice of Testimonial Deposition to be taken on written questions, and requests this Board to issue an order that the deposition be taken on oral examination for good cause shown, pursuant to T.B.M.P. §532. "The determination of whether good cause exists for a motion that a testimonial deposition upon written questions instead be taken by oral examination, is made by the Board on a case-by-case basis, depending upon the particular facts and circumstance in each one." *Id.* In this case, Petitioner has not communicated with Respondent's counsel or otherwise indicated any apparent reason why a deposition on written questions is necessary or appropriate.

Respondent submits that a deposition upon written questions is unfair in this case because Respondent cannot adequately prepare cross-examination questions or follow up questions to the witnesses answers to the very general questions propounded by its own attorney. First, to Respondent's knowledge, this is the only witness that Petitioner intends to call to satisfy its burden of proving that Respondent's valuable trademark rights should be cancelled. On information and belief, all evidence to be submitted in Petitioner's Case in Chief will be put into the record through this witness. No other witnesses have been deposed by either party either during the discovery phase of the case, or during Petitioner's testimony period.

The format for depositions on written questions is not appropriate for this situation, because rather than allowing Respondent a full opportunity to cross examine the witness, it provides the witness an opportunity to be aware of all of the questions in advance, and for his attorney to prepare him to answer those exact questions, without risk of any unexpected inquiry regarding any document or fact. Respondent's cross examination should depend in large

part on what the witness says in direct testimony, which will not be possible at all under the format for a deposition on written questions. Therefore, Respondent will be handicapped in preparing its own defense, because it would not have an opportunity to question the witness directly unless it recalls him during Respondent's testimony period. The fact that "the advantage of being able to confront a witness on cross-examination is lost" has been found by the Board to be "an argument that has merit" and constitutes good cause *Feed Flavors Inc. v. Kemin Industries* (T.T.A.B. 1980).

The only apparent motivation for a deposition on written questions in this case appears to be to either that Petitioner's attorney is in Washington, D.C., while Petitioner's principle place of business is in South Dakota, or it is intended to deprive the Respondent of its opportunity to cross examine the witness at the time of the deposition, to review documents being placed into evidence, to question the authenticity of the documents and the accuracy of any factual information contained therein, and to make proper objections at the time of the deposition. However, in this case the witness is the president of Petitioner, and will be deposed in its home city in South Dakota. Petitioner has selected its own attorney with the knowledge that depositions might require either Petitioner's representatives to travel to Washington, D.C. or its attorney to travel to South Dakota. The rights of Respondent to confront the witness and evaluate and challenge the evidence strongly outweighs any inconvenience to Petitioner.

Respondent reminds this Board that this Cancellation Proceeding is intended to cancel and deprive Petitioner of its trademark registration that was issued five years ago on August 19, 1997. This registration represents valuable rights that have been granted Respondent by the United States Patent and Trademark Office relating to a mark that has been in use for over eight (8) years. Petitioner is making allegations that it has earlier use of an unregistered

trademark, and that Respondent's use of its registered mark in connection with its own goods is likely to be confused with Petitioner's mark. Petitioner carries the burden to prove its case. Respondent has a right to have every opportunity to test the validity of the evidence submitted in support of Petitioner's case.

In this case, the questions submitted by Petitioner's attorney to be propounded were very general and open-ended. The types of questions do not provide Respondent any information of the evidence intended to be put into the record through this witness. The questions included two separate questions with vague references to documents that Petitioner intends to enter as evidence. For example: "I hand you this set of documents marked Exhibit A and ask if you can identify them and explain what they are."<sup>2</sup> See Notice of Testimonial Deposition Under Rule 2.124(b), attached as Exhibit A. However, Petitioner did not provide copies of the documents intended to be authenticated by its witness, or if the documents are limited to those produced in discovery, did not identify them. As a result, under this format, Respondent will not even have an opportunity to know what documents are being put into evidence, to review the documents the witness is expected to identify, and to fully examine the witness on his personal knowledge or the factual information contained therein. Respondent respectfully submits this is just the type of prejudice that will occur if the witness is allowed to testify on written questions.

Respondent strongly objects to this procedure for the deposition, and requests this Board to order a deposition on oral examination, so that Respondent may attend in person or by telephone and properly examine the witness at the time of the deposition. Respondent's counsel will likely attend any scheduled deposition in person. However, since the deposition will

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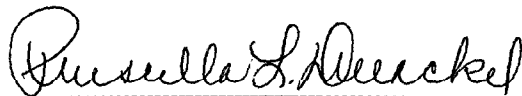
<sup>2</sup> The second vague question is identical, but just refers to Exhibit B instead of Exhibit A.

apparently be taken in South Dakota, Respondent moves for permission to attend the deposition by telephone in the event there are weather problems or other reasons attendance in person will be a problem at the time, and respectfully requests the Board to grant Respondent permission for its counsel to attend by telephone.

Accordingly, for the above noted reasons, Respondent respectfully requests that Respondent's

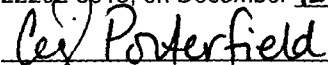
1. Motion to Quash Notice of Deposition or to Strike Trial Testimony Deposition be granted; and
2. Respondent's Motion to Oppose Petitioner's Deposition on Written Questions and Request for Order for Oral Deposition be granted;
3. and Respondent's Motion to Attend Deposition by Telephone be granted.

Respectfully submitted this the 12<sup>th</sup> day of December, 2002



Priscilla L. Dunckel  
Pamela S. Ratliff  
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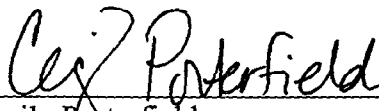
ATTORNEYS FOR RESPONDENT  
BELL PACKAGING CORP.

|                                                                                                                                                                                                                                                                                                                                                 |                    |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 in an envelope addressed to: Box TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on December 12 <sup>th</sup> , 2002. |                    |
|                                                                                                                                                                                                                                                             |                    |
| Name                                                                                                                                                                                                                                                                                                                                            | Cecily Porterfield |
| EV                                                                                                                                                                                                                                                                                                                                              | 073005803 US       |
| Express Mail Cert. No.                                                                                                                                                                                                                                                                                                                          |                    |

**CERTIFICATE OF SERVICE**

I hereby certify that on this the 12<sup>th</sup> day of December, 2002, a true and correct copy of *Respondent's (1a) Motion to Quash Notice of Deposition or (1b) to Strike Trial Testimony. Deposition, and (2) Motion to Oppose Petitioner's Deposition on Written Questions and Request for Order for Oral Deposition; and (3) Motion to Attend Deposition by Telephone* was served, via U.S. First Class Mail, with a courtesy copy provided via facsimile, upon the attorneys of record for Petitioner, addressed to:

J.W. Gipple, Esq.  
GIPPLE & HALE  
P.O. Box 40513  
Washington, D.C. 20016  
Fax: 703.448.7780

  
\_\_\_\_\_  
Cecily Porterfield

**EXHIBIT A**

**NOTICE OF TESTIMONIAL DEPOSITION  
UNDER RULE 2.124(b)**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BELL, INC.

Petitioner

v.

BELL PACKAGING CORP.

Respondent

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Cancellation No. 31904

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**NOTICE OF TESTIMONIAL DEPOSITION**  
**UNDER RULE 2.124(b)**

Bell, Inc., Petitioner in the above identified proceeding, hereby gives notice that on December 2, 2002 it will take the testimonial deposition of Mark Graham, President of Bell, Inc. upon written questions as provided under Rule 2.124(b).

The witness's address is:

1411 D Avenue  
Sioux Falls, South Dakota 57104

The name and address of the officer before whom the deposition is to be taken is:

Maxine Risty  
Dakotah Reporting Agency  
300 N. Dakota Avenue #304  
Sioux Falls, South Dakota

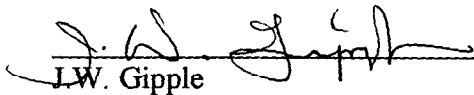
The questions to be propounded are as follows.

These questions are omitted from the Notice filed with TTAB, pursuant to Rule 2.124(b)(1).

1. What is your name, age and citizenship?
2. What, if any, relationship do you have to the Petitioner in proceeding, Bell, Inc.?
3. When did you establish such relationship with Bell, Inc.?
4. Are you familiar with the business of Bell, Inc.?
5. What is that business? More specifically, what products does Bell, Inc. produce and/or sell? In what geographic areas does it sell?
6. Since your initial involvement with Bell, Inc., has there ever been a period when it ceased commercial activities?
7. In dollar terms, what has been the annual sales of Bell, Inc. for the past 10 years?
8. In dollar terms, what has been the annual advertising budget of Bell, Inc. for the past 10 years?
9. I hand you this set of documents marked Exhibit A and ask if you can identify them and explain what they are.
10. Describe the ways in which Bell, Inc. uses and has used the names BELL and BELL PAPER BOX.
11. I hand you a set of documents marked Exhibit B and ask if you can identify them and explain what they are.
12. Does Bell, Inc.'s commercial activities include the service of custom designing paperboard containers for specific customer's needs?

Respectfully submitted,

BELL, INCORPORATED

  
J.W. Gipple  
Gipple & Hale  
Attorneys for Petitioner

November 22, 2002


J.W. Gipple  
GIPPLE & HALE  
(703) 448-1770 Ext. 302  
P. O. Box 40513  
Washington, D.C. 20016  
Attorney Ref.: Z-1604

**CERTIFICATE OF MAILING AND SERVICE**

I hereby certify that the foregoing **NOTICE OF TESTIMONIAL DEPOSITION UNDER RULE 2.124(b)** is being mailed first class U.S. mail, postage prepaid to Counsel for OPPOSER:

Pamela Ratliff, Esquire  
Baker Botts, LLP  
2001 Ross Avenue  
Suite 600  
Dallas, Texas 75201-2980

this 22<sup>nd</sup> day of November, 2002.

  
J.W. Gipple  
Attorney for Applicant

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*TTAB*  
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RIYADH  
WASHINGTON

December 12, 2002

**VIA EXPRESS MAIL: EV 073005803 US**

Priscilla L. Dunckel  
214.953.6618  
FAX 214.661.4899  
priscilla.dunckel@bakerbotts.com

Assistant Commissioner for Trademarks  
TTAB Box No Fee  
2900 Crystal Dr.  
Arlington, VA 22202.3514

12-12-2002

U.S. Patent & TMOc/TM Mail Rcpt Dt. #11

Re: *Bell Inc. v. Bell Packaging Corporation*  
BELL PACKAGING CORPORATION Trademark Cancellation  
Cancellation No. 31,904  
Our File: 019921.0165

Dear Commissioner:

Enclosed please find a copy of the *Respondent's (1a) Motion to Quash Notice of Deposition or (1b) To Strike Trial Testimony Deposition, and (2) Motion to Oppose Petitioner's Deposition on Written Questions and Request for Order for Oral Deposition; and (3) Motion to Attend Deposition by Telephone* to be filed with the Trademark Trial and Appeal Board (TTAB). If you have any questions, do not hesitate to contact me.

Very Truly Yours,



Priscilla L. Dunckel

PLD:ckp

Enclosure

02 DEC 23 AM 9:30